



AF ZEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Appellant: Robert James TRIBE et al.)
Serial No: 09/920,728)
Filed: August 3, 2001)
For: SYRINGE PUMPS) Appeal No.
)
)

REPLY BRIEF TO EXAMINER'S ANSWER

Commissioner for Patents
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Sir:

This is a Reply to the points newly raised by the examiner in her Answer dated January 26, 2005.

Relying on column 5, lines 33-65 and column 6, lines 7-17 of Moberg, the examiner argues that the "occlusion detector (force sensor) does not work by itself, and works in conjunction with a combination of hardware and software such as a control unit or encoder or motor similar to applicants (col. 5, lines 32-49) when there is a problem with the pump mechanism. ... Thus, the combination of hardware and software disclosed inherently acts has a force sensor as it senses an undesired force in the pump mechanism."

In In re Robertson and Scripps, the CAFC states the following:

Anticipation under 35 U.S.C. 102(e) requires that "each and every

element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Cite omitted)

If the prior reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (Cite omitted) Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (Fed. Cir. 169 F.3d 743, 745, 1999)

Moberg is specific in describing how his invention detects occlusion, namely by monitoring one or more motor parameters, such as voltage, current, running time, rotation or linear displacement (column 5, lines 38-43). All of the claims of the Moberg '591 patent are also directed to the detection of motor parameters. There is therefore nothing inherent on how the Moberg invention goes about detecting occlusion. There is simply no use of any force sensor in Moberg. This is clear insofar as that is the essence of the Moberg invention, namely to avoid the need for high pressure limit switches (column 2, lines 5-28). Thus, not only is a force sensor not inherent in Moberg, Moberg actually teaches away from using any force sensor.

The examiner is trying to use the reference made to the Nason (USP 4,562,408) to import the high pressure limit switch 7' shown in the '408 patent to the Moberg device, despite that fact that Moberg teaches to the contrary. It should be

noted in both instances where the '408 patent is incorporated by reference, it was incorporated only to teach the construction of the pump. To wit, column 1, lines 32-36 of Moberg state: "Such infusion pumps are utilized to administer insulin and other medications, with exemplary pump constructions being shown and described in U.S. Pat. Nos. ... 4,678,408..." Also, column 4, lines 27-30 state: "Further details regarding the construction and operation of a medication infusion pump of this general type can be found in U.S. Pat. Nos. ... 4,678,408 ..." This statement is made in a paragraph describing the mechanical arrangement of a pump, its lead screw and the screw nut. Indeed, up to the paragraph in column 4, lines 14-30, Moberg was describing the overall mechanical construction and operation of a conventional pump. Thus, the more appropriate view in regard to what was incorporated by Moberg of the '408 patent is to read the '408 patent as providing further details in regard to the overall mechanical construction and mechanical operation of a conventional pump.

Moreover, it should be appreciated that, *in arguendo*, even if the high pressure switch described in the '408 were added to the Moberg device, such switch would be redundant, as its function and presence are completely contrary to what is taught and described in Moberg.

To the extent that the last two sentences in the paragraph bridging pages 5 and 6 of the Examiner's Answer is understood, Appellant respectfully submits that column 1, line 58 to column 2, line 28 set forth the problems of the prior art which Moberg intends to overcome. And the way in which Moberg overcomes the problems of the prior art was to eliminate the use of high pressure limit switches, and instead rely upon monitoring one or more of the motor parameters such as voltage, current, etc. as pointed out earlier.

It is moreover apparent that the force sensor is not inherently described in Moberg as there is no disclosure in Moberg of the plunger of the infusion pump being reversed until the force detected by the force sensor has fallen by a predetermined amount or value, or has detected an absence of an excessive force, as required by the being appealed claims.

Accordingly, Moberg does not disclose, nor is there any suggestion provided in Moberg, that the plunger drive be reversed until the force detected by the force senor has fallen by a predetermined amount, as required in claim 1; or when there is an absence of excessive force, as required in claim 5; or when the detected force is reduced below a predetermined value as required in claim 7.

In view of the above, Appellants respectfully request the reversal of the rejections of the pending claims.

Respectfully submitted,


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